REMARKS

Applicant hereby traverses the outstanding rejections, and requests reconsideration and withdrawal in light of the remarks contained herein. Claim 1 has been amended and claim 3 has been canceled. Claims 1, 2, and 4-24 are pending in this application.

The Examiner's Characterization of the Invention

The Applicant objects to the Examiner's characterization of the present invention in paragraph 3 of the present office action. While the Examiner's terminology may be similar, the Applicant respectfully asserts the only proper characterization of the invention is found in the claims as written.

Rejection under 35 U.S.C. § 103

Claims 1, 3-9, 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,862,223 to Walker et al. (hereinafter "Walker") in view of U.S. Patent Number 6,325,632 to Chao et al. (hereinafter "Chao").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first or second criteria, Applicant asserts that the rejection does not satisfy the third criteria.

Claim 1, as amended, requires maintaining an updateable and searchable database of expert profiles, wherein the profiles include attributes of a particular expert, and wherein one of the attributes is the expert's real-time availability. Neither Walker, nor Chao disclose maintaining ... the expert's real-time availability. Walker is an on-line exchange for matching user requests with an appropriate expert. Column 7, lines 6-14. As part of the exchange, a user sends a request which is routed to appropriate experts, who can then bid on the job. Column 7, lines 15-34. The Examiner, with reference to claim 3, has noted that the exchange of Walker can keep the experts availability standards. Column 14, lines 27-28. Given the nature of the exchange itself, namely that requests are sent, and bids are collected,

it is apparent that the availability standard noted by the Examiner cannot be real-time availability as required by claim 1.

Chao is not relied upon by the Examiner as teaching availability. It is clear from Chao that the availability of the instructor is not kept because Chao attempts to establish a session which may fail because the instructor or student is not available. Column 5, line 66 through column 6, line 4. If real-time availability were kept as an attribute, Chao would not attempt to establish a session if it knew the instructor was not available.

As neither Walker, nor Chao disclose maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability, the combination of references do not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 3 has been canceled. Claims 4-9, 15 and 16 depend from claim 1, and are allowable as being dependent from an allowable base claim for at least the reasons set forth above with respect to claim 1. Specifically, claims 4-9, 15 and 16 each require, through their dependencies from claim 1, maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability. For the reasons set forth with respect to claim 1, neither Walker, nor Chao describe at least these limitations. Applicant, therefore, respectfully asserts that claims 4-9, 15 and 16 are allowable, for at least the reasons set forth, over the 35. U.S.C. §103 rejection.

Claims 17, 20 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker and further in view of Chao in view of U.S. Patent Number 5,544,049 to Henderson et al. (hereinafter "Henderson").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P.

§ 2143. Without conceding the second or third criteria, Applicant asserts that the rejection does not satisfy the first criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The Examiner stated that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Applicant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose.

As stated above, Walker describes an exchange service where requests from users solicit bids from competing instructors. Column 7, lines 6-34. Walker does not return a list of experts to the user which can be ranked, instead it submits the request and returns bids. There is no list to rank and imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view of Chao and further in view of Henderson put forth by the Examiner, therefore, does not comport with the requirements of M.P.E.P. § 2143.01 and is, therefore, improper. Therefore, the rejection of claims 17, 20 and 21 should be withdrawn.

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, and further in view of Henderson.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first or third criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As set forth above, the Examiner stated that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Applicant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose.

As previously stated, Walker describes an exchange service where requests from users solicit bids from competing instructors. Column 7, lines 6-34. Walker does not return a list of experts to the user which can be ranked, instead it submits the request and returns bids. There is no list to rank and imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view Chao in view of Henderson put forth by the Examiner, therefore, does not comport with the requirements of M.P.E.P. § 2143.01 and is, therefore, improper. Therefore, the rejection of claim 2 should be withdrawn.

Further, the combination cited by the Examiner lacks all of the limitations found in claim 2. Claim 2 depends from claim 1, and requires, through its dependency from claim 1, maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability. For the reasons set forth with respect to claim 1, neither Walker, Chao, nor Henderson describe at least these limitations. Applicant, therefore, respectfully asserts that claim 2 is allowable, for at least the reasons set forth, over the 35. U.S.C. §103 rejection.

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, in view of Henderson and further in view of keen.com.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first or third criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As stated, the Examiner stated that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Applicant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose.

Further, the Examiner has stated that it would have been obvious to combine the teachings of Walker with the teachings of keen.com to provide the ability to automatically connect a user to a selected Expert. The motivation being that it would be the quickest method of establishing a connection between the user and expert, thus expediting the process. The Examiner is again overlooking that Walker is an on-line exchange which receives requests and submits them for bids. In such a bid request paradigm, Walker does not return a list of experts to the user which can be ranked as in Henderson, or connected immediately as in keen.com, instead it submits the request and returns bids. There is no list to rank and no listed names to automatically connect. Imposing the ranked list of Henderson and/or the "call now" feature of keen.com on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view of Chao in view of Henderson and further in view of keen.com put forth by the Examiner, therefore, does not comport with the requirements of M.P.E.P. § 2143.01 and is, therefore, improper. Therefore, the rejection of claim 10 should be withdrawn.

Further, the combination cited by the Examiner lacks all of the limitations found in claim 10. Claim 10 depends from claim 1, and requires, through its dependency from claim 1, maintaining ... attributes of a particular expert, ... wherein one of the attributes is the

expert's real-time availability. The Examiner has cited keen.com web pages in the rejection of claim 10 as teaching a method wherein the user is automatically connected to a selected expert using a "Call Now" icon on the list of experts. The "Call Now" icon does not indicate that the expert would be available at that moment, and it appears to be always part of the list which would indicate that the expert may be available or the user may have to leave a message. It is apparent, therefore, that the keen.com website does not keep the real-time availability of the expert as required by claim 1, but merely has a one-click method to contact the expert. For the reasons set forth above and with respect to claim 1, neither Walker, Chao, Henderson, nor the web pages of keen.com describe at least these limitations. Applicant, therefore, respectfully asserts that claim 10 is allowable, for at least the reasons set forth, over the 35. U.S.C. §103 rejection.

Claim 11-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, in view of Henderson and further in view of U.S. Patent Number 6,223,165 to Lauffer (hereinafter "Lauffer").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first or third criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As stated, the Examiner stated that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Applicant respectfully asserts that the teaching of

Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose.

As before, the Examiner overlooks that Walker is an on-line exchange which receives requests and submits them for bids. In such a bid request paradigm, Walker does not return a list of experts to the user which can be ranked as in Henderson, instead it submits the request and returns bids. There is no list to rank, and imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view of Chao in view of Henderson and further in view of Luaffer put forth by the Examiner, therefore, does not comport with the requirements of M.P.E.P. § 2143.01 and is, therefore, improper. Therefore, the rejection of claims 11-14 should be withdrawn.

Further, the combination cited by the Examiner lacks all of the limitations found in claims 11-14. Claims 11-14 depend from claim 1, and requires, through their dependencies from claim 1, maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability. For the reasons set forth with respect to claim 1, neither Walker, Chao, Henderson, nor Lauffer describe at least these limitations. Applicant, therefore, respectfully asserts that claims 11-14 are allowable, for at least the reasons set forth, over the 35. U.S.C. §103 rejection.

Claims 18, 19, 22 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, in view of Henderson and further in view of U.S. Patent Number 6,370,231 to Hice (hereinafter "Hice").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second or third criteria, Applicant asserts that the rejection does not satisfy the first criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion

or motivation to make the proposed modification. M.P.E.P. § 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As stated, the Examiner stated that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Applicant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose.

Further, the Examiner has stated that it would have been obvious to combine the teachings of Walker with the teachings of Hice to incorporate the task management system of Hice with the expert identification system. The motivation being that it would allow clients to receive timely information on the status of a given expert and the expert's availability. The Examiner is again overlooking that Walker is an on-line exchange which receives requests and submits them for bids. In such a bid request paradigm, Walker does not return a list of experts to the user which can be ranked as in Henderson, or track the status of a given expert or the expert's availability, instead it submits the request and returns bids. There is no list to rank and no mechanism for tracking expert status or availability in the request/bid process. Imposing the ranked list of Henderson and/or the task management system of Hice on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view of Chao, in view of Henderson and further in view of Hice put forth by the Examiner, therefore, does not comport with the requirements of M.P.E.P. § 2143.01 and is, therefore, improper. Therefore, the rejection of claims 18, 19, 22 and 23 should be withdrawn.

Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao in view of Henderson in view of Hice and further in view of U.S. Patent Number 5,570,100 to Grube et al. (hereinafter "Grube").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second or third criteria, Applicant asserts that the rejection does not satisfy the first criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As stated, the Examiner stated that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Applicant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose.

Further, the Examiner has stated that it would have been obvious to combine the teachings of Walker with the teachings of Hice to incorporate the task management system of Hice with the expert identification system. The motivation being that it would allow clients to receive timely information on the status of a given expert and the expert's availability. The Examiner is again overlooking that Walker is an on-line exchange which receives requests and submits them for bids. In such a bid request paradigm, Walker does not return a list of experts to the user which can be ranked as in Henderson, or track the status of a given expert or the expert's availability, instead it submits the request and returns bids. There is no list to rank and no mechanism for tracking expert status or availability in the request/bid process. Imposing the ranked list of Henderson and/or the task management system of Hice on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view of Chao in view of Henderson in view of Hice and further in view of Grube put forth by the Examiner, therefore, does not comport with the requirements of M.P.E.P. § 2143.01 and is, therefore, improper. Therefore, the rejection of claim 24 should be withdrawn.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10015906-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482745812US in an envelope addressed to: MS AF, Commissioner for Patents, Alexandria, VA 22313.

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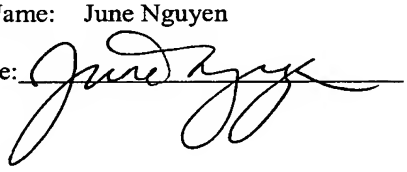
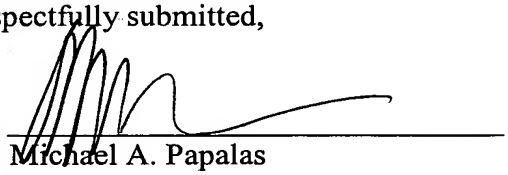
Signature: 

Respectfully submitted,

By: 

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